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OFFICE OF PETITIONS

In re Application of :
Srivastava et al. : DECISION ON
Application No. 09/750,972 : APPLICATION FOR
Filed: December 28, 2000 : PATENT TERM ADJUSTMENT
Atty Docket No. 8449-134 :
:

This is a decision on the "APPLICATION FOR PATENT TERM ADJUSTMENT UNDER 37 C.F.R. § 1.705(b)," filed November 16, 2006. Applicants request that the initial determination of patent term adjustment under 35 U.S.C. 154(b) be corrected from zero (0) days to six hundred forty (640) days.

The application for patent term adjustment is **GRANTED TO THE EXTENT INDICATED HEREIN.**

The Office has updated the PAIR screen to reflect that the correct Patent Term Adjustment (PTA) determination at the time of the mailing of the Notice of Allowance is four hundred twelve (**412**) days. A copy of the updated PAIR screen, showing the correct determination, is enclosed.

On August 23, 2006, the Office mailed the Determination of Patent Term Adjustment under 35 U.S.C. 154(b) in the above-identified application. The Notice stated that the patent term adjustment (PTA) to date is 0 days. On November 16, 2006, applicants timely submitted the instant application for patent term adjustment¹. Applicants contend that the period of adjustment for Office delay should be 741 days rather than 27 days. Citing 37 C.F.R. § 1.702(a)(2), applicants argue for 714

¹ PALM records indicate that the Issue Fee payment was received on November 16, 2006.

additional days of adjustment on the basis that the Office took until March 13, 2006 to respond to their response filed November 28, 2003.

Applicants are correct that this is a proper basis for entry of an additional period of adjustment. However, the number of days in the period beginning on March 29, 2004 and ending on March 13, 2006 is 715 days, not 714 days. Accordingly, a period of adjustment of 715 days has been entered.

However, a review of the application history also reveals further bases for entry of periods of reduction for applicant delay. 37 CFR 1.704(c) provides, in pertinent part that:

Circumstances that constitute a failure of the applicant to engage in reasonable efforts to conclude processing or examination of an application also include the following circumstances, which will result in the following reduction of the period of adjustment set forth in § 1.703 to the extent that the periods are not overlapping:

(8) Submission of a supplemental reply or other paper, other than a supplemental reply or other paper expressly requested by the examiner, after a reply has been filed, in which case the period of adjustment set forth in § 1.703 shall be reduced by the number of days, if any, beginning on the day after the date the initial reply was filed and ending on the date that the supplemental reply or other such paper was filed;

37 CFR 1,704(d) provides that:

A paper containing only an information disclosure statement in compliance with §§ 1.97 and 1.98 will not be considered a failure to engage in reasonable efforts to conclude prosecution (processing or examination) of the application under paragraphs (c)(6), (c)(8), (c)(9), or (c)(10) of this section if it is accompanied by a statement that each item of information contained in the information disclosure statement was first cited in any communication from a foreign patent office in a counterpart application and that this communication was not received by any individual designated in § 1.56(c) more than thirty days prior to the filing of the information disclosure statement. This thirty-day period is not extendable.

In this instance, applicants filed a supplemental response on June 9, 2003 after having filed a response on June 4, 2003. In addition, after filing a response on November 28, 2003, on July 9, 2004, applicants filed an Information Disclosure Statement (IDS). The record does not support a conclusion that either the response or IDS was expressly requested by the examiner. Furthermore, the IDS did not include a § 1.704(d) statement. Thus, a period of reduction of 5 days is warranted for the filing of the response on June 9, 2003 and a reduction of 224 days is warranted for the filing of the IDS on July 9, 2004.

The determination of patent term adjustment at the time of the mailing of the Notice of Allowance is four hundred twelve (412) days (715 + 27 days of Office delay reduced by 101 + 224 + 5 days of applicant delay).

Receipt of the \$200.00 fee set forth in 37 CFR 1.18(e) is acknowledged. No additional fees are required.

The application is being forwarded to the Office of Patent Publication for issuance of the patent. The patent term adjustment indicated on the patent (as shown on the Issue Notification mailed about three weeks prior to patent issuance) will include any additional adjustment accrued both for Office delay in issuing the patent more than four months after payment of the issue fee and satisfaction of all outstanding requirements, and for the Office taking in excess of three years to issue the patent (to the extent that the three-year period does not overlap with periods already accorded).

Telephone inquiries specific to this matter should be directed to the undersigned at (571) 272-3219.



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Office of Petitions

Enclosure: Updated PAIR Screen